

REMARKS

Favorable and prompt allowance of the pending claims in the application is respectfully requested on the basis of the following particulars.

1. Rejection of claims 24-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*) and U.S. patent 4,479,333 (*Hendrich*)

This rejection is respectfully traversed on the basis that the proposed combination of *Meckstroth*, *Haffner* and *Hendrich* fails to render pending claims 24-33 *prima facie* obvious.

The basis for this traversal is due to the overall failure of the proposed combination of *Meckstroth*, *Haffner* and *Hendrich* of teaching every limitation of the pending claims, and the lack of motivation, whether implicitly or explicitly, among these references to combine them to make the set of packaged decorative floor panels of the pending claims. Simply put, a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventors of the pending claims, would not have been led to make the combination recited in the claims.

In the rationale for the rejection, the office action uses *Meckstroth* as the principal reference for teaching all of the limitations in the claims with the exception for the teaching of a decorative paper layer soaked in resin (*Haffner*), and the teaching providing a set of floor panels in a single package (*Hendrich*). However, in observing *Meckstroth*, this reference does not teach all of the limitations identified in the action, and *Hendrich* similarly fails to teach that which is alleged in the action.

First, *Meckstroth* does not disclose or suggest a “set” of floor panels for composing a “decorative” floor covering. Instead, it is clear from *Meckstroth* that it relates to “structural” panels for building components (col. 2, lines 14-18). As explained by *Meckstroth*, the structural panels are for use in buildings such as

modular dwelling units, housing sections, or building panels which are provided for forming connections between modules (col. 1, lines 11-15). In no manner would one skilled in the art be motivated to install the structural panel of *Meckstroth* over an already existing structural panel.

In observing the construction of the structural panels in *Meckstroth*, one of ordinary skill in the art would readily recognize that these panels are of a completely different nature from decorative floor panels. Namely, *Meckstroth* requires that each panel include a vertical frame member (12), an outer skin formed by a sheet (14) of rough-sawn exterior plywood scored at spaced intervals to receive horizontally spaced battens, and an inner skin formed of a sheet (12) of dry wall (col. 2, lines 21-36). Obviously, from the robust construction of the structural panels of *Meckstroth*, the skilled artisan would understand that in no way would the panels of *Meckstroth* be adapted for use as a decorative floor covering, and would thus not consult with *Meckstroth* in making such a decorative floor covering.

Just as much as one skilled in the art would not consult with *Meckstroth* to make a decorative floor covering, the skilled artisan would find no sense in combining the teachings of *Meckstroth* with those of *Haffner*. While *Haffner* relates to a laminate flooring, it does not relate to structural panels. There is no suggestion in *Meckstroth*, or sufficient rationale in the office action that shows how one skilled in the art would bridge the gap in teachings between the two different types of panels taught by *Meckstroth* and *Haffner*. This not only begs the question as to why a skilled artisan would provide a structural layer with a decorative layer, but how would a skilled artisan provide the decorative layer on the structural panel of *Meckstroth* and upon which of the “skins” of the panel in *Meckstroth*. From the description of *Meckstroth* and the rationale articulated in the action, there is simply no evidence that would tend to suggest to one skilled in the art of replacing the skins in the panel of *Meckstroth*, or alternatively, covering one of the skins with a decorative layer.

As mentioned above, the rejection in the action provides no basis as to how one skilled in the art would apply a decorative layer to the structural panels of *Meckstroth*, and moreover there is no evidence, whether implicit or explicit, of any desire in *Meckstroth* of providing the structural panels with the decorative layer of *Haffner*. It is well understood that a rejection based on obviousness must provide some rationale, articulation or reasoned basis to explain why these references would be combined by the skilled artisan. Indeed, it is submitted that the combined teachings of *Meckstroth* and *Haffner*, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would not have suggested to one skilled in the art the notion of providing the structural layer of *Meckstroth* with a decorative paper layer of *Haffner*.

Next, while *Meckstroth* teaches that the structural panels may be provided in different widths or lengths, there is no suggestion by *Meckstroth* of providing sets with such differently sized panels. The pending claims require a “set” of floor panels having panels of at least two different lengths. *Meckstroth*, on the other hand, merely indicates that the panels may be prefabricated in different widths or lengths (col. 2, lines 50-55), but in no way teaches that these differently size panels may be provided in a set that includes panels of different dimensions.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the action, col. 2, lines 50-55, merely conveys that panels of different dimensions may be produced according to different applications such as “depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels.” From this passage, without the hindsight of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panels may have a certain width that is different from the roof panels.

In view of these observations, it is submitted that nowhere is there any indication in *Meckstroth* that would teach one skilled in the art the notion of providing a set of panels having different dimensions. Neither *Haffner* nor *Hendrich* make up for such shortcomings of *Meckstroth*.

Lastly, it is submitted that the addition of *Hendrich* with the teachings of *Meckstroth* and *Haffner*, fails to convey to one skilled in the art the feature of the pending claims wherein the set of floor panels are provided in a single package. *Hendrich* is provided in the combination as a supposed teaching that it would be obvious to “package building structures for transportation to a building site,” yet such a teaching has no effect on the express limitation in the claims requiring that the set of panels is provided in a single package.

Hendrich relates to complex folding building structural elements hingedly connected to one another to form building modules (col. 2, lines 11-17). Such building modules of *Hendrich* include structural floor elements hingedly connected to roof elements, as aptly portrayed in Fig. 1. It is submitted that hingedly connected structures and floor panels having decorative layers are inapposite, and, as such, one skilled in the art would neither turn to the teachings of *Hendrich* nor find any motivation from *Hendrich* to provide decorative floor panels in a single package.

While it is true that *Hendrich* teaches transporting the modules by a truck or a rail car, there is no teaching of placing such modules in a “single” package or packages of any type. Furthermore, due to the sheer size of the structural building modules of *Hendrich*, as evidenced by the hingedly connected roof and floor elements of Fig. 1 of *Hendrich* and the description that such panels must be transported by rail or truck (col. 3, 14-17), it is clear that one skilled in the art would easily recognize that such modules would not be provided in a single package of the type that is readily known to one skilled in the art of decorative floor panels.

The action provides no grounds as to how one skilled in the art would be motivated to combine *Hendrich* with the teachings of *Meckstroth* and *Haffner*.

Instead, there is a conclusory statement that one skilled in the art would have “appreciated packaging the materials in any convenient, efficient and low cost manner.” This statement is rather conclusory in nature, and lacks any articulated reasoning with some rational underpinning to support the conclusion of legal obviousness.

Indeed, the claims of the pending application present a specific manner for packaging a certain type of panels in the form of decorative floor panels that is not taught by the combination of prior art references. The manner for packaging the floor panels of the instant application departs from the traditional manner of packaging decorative floor panels of a same size in a single package. This results in the need for manufacturers to sell different packages of individual dimensions.

The pending claims recite a manner that provides a mixture of different sized decorative floor panels in a single package. This provides significant benefits which are not foreseen by the prior art, including the proposed combination of *Meckstroth*, *Haffner* and *Hendrich*. These benefits address providing panels of at least two different sizes when installing a decorative floor covering, and mitigating the need for the installer to purchase an excess amount of panels of a certain size when few are required (specification on page 2, line 28 through page 3, line 5). It flows from this benefit that there is a sufficient mixture of sized panels for the installer (specification on page 8, lines 4-15).

Another benefit is that the manner of providing the differently sized decorative panels in the sets required by the claims is that a distributor need only stock a few types of floor panels without much concern as to the sizes of the panels. A drawback in known methods of packaging decorative floor panels is that since the floor panels are sold in different lengths in different boxes, some sizes are sold in higher amounts than others. Since it is difficult for the distributor to anticipate the sales of different sizes, a mixture of sizes can be provided in a single package so as to reduce the overall stock of panels (specification on page 8, lines 17-26).

Because *Meckstroth* and *Hendrich* relate to structural panels for building construction, and further because there is an overall absence of the concept of decorative floor packaging in *Haffner*, one skilled in the art would not appreciate the benefits presented by the manner of the pending claims for packaging decorative floor panels. Further, due to the advantages provided by decorative floor packaging of the pending claims, it is clear that the subject matter of the pending claims is not obvious in view of the prior art, inclusive of the proposed combination, and one skilled in the art would not just simply combine *Meckstroth*, *Haffner* and *Hendrich* to arrive at the specific manner required by the pending claims.

In the view of these observations, it is submitted that the proposed combination of *Meckstroth*, *Haffner* and *Hendrich* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover, there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed combination to devise the set of packaged decorative floor panels according to the pending claims. Accordingly, withdrawal of the rejection is respectfully requested.

2. Rejection of claims 24-33 based on provisional double patenting over claims 1-9 of co-pending application no. 11/249,591

A terminal disclaimer is submitted herewith regarding the provisional double patenting rejection of claims 24-33 over claims 1-9 of co-pending application no. 11/249,591. Because of the terminal disclaimer, withdrawal of this rejection is respectfully requested.

3. Conclusion

As a result of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Justin J. Cassell', written over a horizontal line.

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